UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,087	03/02/2004	Hiroki Iwahashi	1081.1192	1171

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EXAMINER
LASTRA, DANIEL

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 12/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _02 March 2004_.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-24_ is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-24_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
   application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _03/02/04_.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1.   Claims 1-24 have been examined. Application 10/790,087 has a filing date 03/02/2004 and is a continuation of PCT/JP01/09018 International Filing Date: 10/12/2001.

Claim Rejections - 35 USC § 102

2.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 4, 5, 8-12, 15, 16, 19-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Freeman et al (U.S. 6,068,183).

As per claim 1, Freeman teaches:

A method of providing advertisements by an automatic transaction apparatus for executing a predetermined transaction with a user utilizing a transaction medium that stores identification information of the user, the method comprising the steps of:

reading the identification information stored in the transaction medium (see column 4, lines 60-67);

acquiring attribute information of the user corresponding to the identification information read out from the transaction medium, from a host computer connected with the automatic transaction apparatus through a network (see column 3, lines 45-55; column 5, lines 1-10; column 4, lines 35-40); and

displaying an advertisement corresponding to the attribute information among a plurality of advertisements registered for each of plural pieces of attribute information (see .

As per claim 4, Freeman teaches

The method of providing advertisements according to claim 1, wherein in the case where a plurality of advertisements are registered for the attribute information, one advertisement is selected for display depending on the priority set in advance for each advertisement (see column 4, lines 60-67; column 5, lines 44-65).

As per claim 5, Freeman teaches:

The method of providing advertisements according to claim 1, wherein the automatic transaction apparatus issues a coupon corresponding to the advertisement after displaying the advertisement (see column 4, lines 60-67).

As per claim 8, Freeman teaches:

The method of providing advertisements according to claim 5, wherein the automatic transaction apparatus issues the coupon by either printing of the coupon on a predetermined sheet or registering of data into the transaction medium (see column 3, lines 55-67; column 4, lines 60-65).

As per claim 9, Freeman teaches:

The method of providing advertisements according to claim 8, wherein the automatic transaction apparatus accumulates the number of times of issuance of the coupon for each issuance either by the printing or by the registering of data (see column 2, lines 25-29).

As per claim 10, Freeman teaches:

The method of providing advertisements according to claim 1, wherein the attribute information includes at least one of the age, the sex and the balance in a deposit account set in a predetermined financial institution of the user (see column 3, lines 45-55).

As per claim 11, Freeman teaches:

The method of providing advertisements according to claim 1, wherein the transaction medium is an IC card (see column 2, lines 9-30).

As per claim 12, Freeman teaches:

An automatic apparatus for executing a predetermined transaction with a user utilizing a transaction medium that stores identification information of the user, the automatic transaction apparatus comprising:

a read-out unit for reading out the identification information stored in the transaction medium;

an acquisition unit for acquiring attribute information of the user corresponding to the identification information read out from the transaction medium, from a host computer connected with the automatic transaction apparatus through a network;

a storage unit for storing at least one advertisement corresponding to each of plural pieces of attribute information; and

a display unit for displaying the advertisement corresponding to the attribute information from advertisements stored in the storage unit. The same rejection applied to claim 1 is applied to claim 12.

As per claim 15, Freeman teaches:

The automatic transaction apparatus according to claim 12, wherein the display unit selects one advertisement depending on the priority set in advance for each advertisement and displays the selected advertisement in the case where a plurality of advertisements are registered for the attribute information. The same rejection applied to claim 4 is applied to claim 15.

As per claim 16, Freeman teaches:

The automatic transaction apparatus according to claim 12, wherein the automatic transaction apparatus further comprises an issuance unit for issuing a coupon corresponding to the advertisement after displaying the advertisement. The same rejection applied to claim 5 is applied to claim 16.

As per claim 19, Freeman teaches:

The automatic transaction apparatus according to claim 16, wherein the issuance unit issues the coupon by either printing of the coupon on a predetermined sheet or registering of data into the transaction medium. The same rejection applied to claim 8 is applied to claim 19.

As per claim 20, Freeman teaches:

The automatic transaction apparatus according to claim 19 wherein the calculation unit accumulates the number of times ..of issuance of. the coupon for each of the issuance by the printing or by the registration of data. The same rejection applied to claim 9 is applied to claim 20.

As per claim 21, Freeman teaches:

The automatic transaction apparatus according to claim 12 wherein the attribute information includes at least one of the age, the sex and the balance in a deposit account set in a predetermined financial institution of the user. The same rejection applied to claim 10 is applied to claim 21.

As per claim 22, Freeman teaches:

The automatic transaction apparatus according to claim 12, wherein the transaction medium is an IC card. The same rejection applied to claim 11 is applied to claim 22.

As per claim 23, Freeman teaches:

A transaction system executing a predetermined transaction with a user, the transaction system comprising:

an automatic transaction apparatus for accepting a transaction medium that stores identification information of the user; and

a host computer for communicating attribute information of the user, connected with the automatic transaction apparatus through a network, the automatic transaction apparatus comprising:

a read-out-unit for reading out the identification information stored in the

transaction medium;

an acquisition-unit-for acquiring attribute information of the user corresponding to

the identification information read out from the transaction medium from a host

computer;

a storage unit for storing at least one advertisement corresponding to each of

plural pieces of attribute information; and

a display-unit for displaying the advertisement corresponding to the attribute information

from advertisements stored in the storage-unit. The same rejection applied to claim 1 is

applied to claim 23.

As per claim 24, Freeman teaches:

The transaction system according to claim 23, wherein the automatic transaction

apparatus issues a coupon corresponding to the advertisement after displaying the

advertisement. The same rejection applied to claim 5 is applied to claim 24.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

Claims 2, 3, 6, 7, 13, 14, 17 and 18 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Freeman et al (U.S. 6,068,183) in view of Angles et al (U.S.

5,933,811).

As per claim 2, Freeman teaches

The method of providing advertisements according to claim 1, but fails to teach wherein: the automatic transaction apparatus accumulates the number of times of display of the advertisement every time it displays the advertisement, and wherein the host computer acquires the number of times of display of the advertisement from the automatic transaction apparatus and, after a predetermined period of time has passed, creates charging information corresponding to the number of times of display. However, Angles teaches "In addition, the ability to monitor the number of advertisements displayed by a particular content provider computer 14 provides a number of advantages. For example, the advertisement provider can pay the content provider based on the volume of advertisements actually displayed by the content provider computer 14. This frees the content providers from having to generate advertising data, from having to individually contact advertisers, from having to negotiate advertising payment fees, and from having to maintain an advertising administrative staff. (105) Furthermore, because the preferred embodiment of Angles also is capable of storing a consumer's Internet provider account number in the registration database 68, the preferred embodiment can monitor the number of advertisements viewed by consumers associated with a particular Internet provider 34. Accordingly, the invention can pay an Internet provider 34 based on the number of advertisements viewed by its consumers. The Internet providers 34 can then use this advertising revenue to reduce consumer access fees. Alternatively, the preferred embodiment can pay a consumer for viewing advertisements by crediting a consumer's Internet provider account. In addition,

because the preferred embodiment also is capable of storing a consumer's digital cash

account, the preferred embodiment can pay the consumer with digital cash each time

the consumer views an advertisement. This allows the consumer to obtain digital cash

which the consumer can use to purchase other goods and services offered for sale on

the Internet 33" (see column 16, lines 16-44). Therefore, it would have been obvious to

a person of ordinary skill in the art at the time the application was made, to know that

the Freeman system would track and analyze the number of times advertisements are

displayed to users, as taught by Angles. Freeman would use this tracking to analyze the

effectiveness of the advertisement efforts and would use this analysis to settle

transactions between consumers, advertisers and content providers.

As per claim 3, Freeman and Angles teach:

The method of providing advertisements according to claim 2, wherein in the

case where the advertisement is registered for the plural pieces of the attribute

information, the number of times of display of the advertisement is accumulated for

each piece of the attribute information (see column 4, lines 60-67). The same rejection

applied to claim 2 is applied to claim 3.

As per claim 6, Freeman teaches:

The method of providing advertisements according to claim 5, but fails to teach

wherein the automatic transaction apparatus accumulates the number of times of

issuance of the coupon every time it issues the coupon, and the host computer acquires

the number of times of issuance from the automatic transaction apparatus and, after a

predetermined period of time has passed, creates charging information corresponding

to the number of times of issuance. The same rejection applied to claim 2 is applied to claim 6.

As per claim 7, Freeman and Angles teach:

The method of providing advertisements according to claim 6, wherein in the case where the advertisement and a coupon corresponding thereto are registered for the plural pieces of attribute information, the number of times of display of the advertisement and the number of times of issuance of the coupon are accumulated for each piece of attribute information (see column 3, lines 45-55; column 4, lines 17-34; column 2, lines 20-30).

As per claim 13, Freeman and Angles teach:

The automatic transaction apparatus according to claim 12, wherein the automatic transaction apparatus comprises a calculation unit for accumulating the number of times of display of the advertisement every time the advertisement is displayed, and wherein the calculation unit transmits the number of times of display of the advertisement to the host computer that creates charging information corresponding to the number of times of display after a predetermined period of time has passed. The same rejection applied to claim 2 is applied to claim 13.

As per claim 14, Freeman and Angles teach:

The automatic transaction apparatus according to claim 13, wherein the calculation unit accumulates the number of times of display of the advertisement for each piece of the attribute information in the case where the advertisement is registered

for the plural pieces of attribute information. The same rejection applied to claim 3 is applied to claim 14.

As per claim 17, Freeman and Angles teach:

The automatic transaction apparatus according to claim 16 wherein the automatic transaction apparatus comprises a calculation unit for accumulating the number of times of issuance of the coupon every time the coupon is issued, and wherein the calculation unit transmits the number of times of issuance to the host computer that creates charging information corresponding to the number of times of issuance after a predetermined period of time has passed. The same rejection applied to claim 6 is applied to claim 17.

As per claim 18, Freeman and Angles teach:

The automatic transaction apparatus according to claim 17, wherein

the calculation unit accumulates the number of times of display of the advertisement and the number of times of issuance of the coupon for each piece of the attribute information in the case where the advertisement and a coupon corresponding thereto are registered for the plural pieces of attribute information. The same rejection applied to claim 7 is applied to claim 18.

Conclusion

4.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 703-306-5933. The examiner can normally be reached on 9:30-6:00.
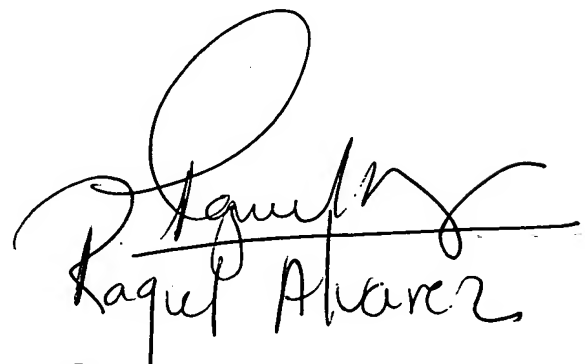
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W STAMBER can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DL

Daniel Lastra
November 27, 2004

Raquel Alvarez
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